

REMARKS:

Claims 1, 3, 6, and 11 have been amended herein in response to the arguments presented in the office action. Claims 1, and 11 have been amended to delete the words “chemically inert” and to insert language providing that the probe protein does not form a covalent bond with R². Basis for these amendments may be found in the specification, e.g. at pages 4, 5, 7, 16-18, 24, in the claims, and elsewhere in the specification. Claim 3 has been amended to insert language providing that the blocking protein does not form a covalent bond with R². Basis for this amendment may be found in the specification, e.g. at pages 4, 5, 7, 16-18, 24, in the claims, and elsewhere in the specification. Claim 6 has been amended to read that the plurality of blocking proteins are selected to reduce non-specific binding of target protein, and basis for this amendment may be found at pages 17-18, in the claims, and elsewhere in the specification.

Claims 1-18 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. In response, Applicants have now amended claims 1, 3, and 11. Applicants submit that the amendments address the rejection and the rejection should be withdrawn.

Claims 6 and 18 were rejected under 35 USC §112, second paragraph, as being indefinite. In response, Applicants have now amended claims 6 and 11 (on which claim 18 depends). Applicants submit that the amendments address the rejection and the rejection should be withdrawn.

Claims 1-8, 10-13, and 15-18 were rejected under 35 USC §103(a) as unpatentable over Haab et al. in view of Lefkowitz et al. and in light of Kusnezow et al.

Further, claim 9 was rejected under 35 USC §103(a) as unpatentable over Haab et al. in view of Lefkowitz et al. and in light of Kusnezow et al. and further in view of BD Biosciences.

Further, claim 14 was rejected under 35 USC §103(a) as unpatentable over Haab et al. in view of Lefkowitz et al. and in light of Kusnezow et al. and further in view of Silzel et al.

Thus, the *prima facie* case of obviousness alleged in the office action with regard to all of claims 1-18 relies on a combination of Haab et al. and Lefkowitz et al. A finding of *prima facie* obviousness is a procedural tool which, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion the Examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, three criteria must be met: first, the prior art reference must teach or suggest the desirability of the claimed combination; second, the Office must show that the ordinary artisan would be motivated to modify the reference or to combine the reference teachings; and third, there must be a showing that the ordinary artisan would have a reasonable expectation of success at arriving at the claimed combination based *solely* on the teachings of the cited prior art reference. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

As mentioned in the office action, the polylysine coated surface described in Haab et al. binds non-covalently to the antigens or antibodies used as probes in Haab et al. The Lefkowitz et al. reference describes a method of providing active groups to covalently bond the probe proteins to the surface of the described arrays. The nature of the surface as described in the cited art is tied to the characteristic mode of binding of the surface. The office action has not described how the cited references may be combined to choose the described chemical nature of the surface from one reference, yet expect that the chosen chemical nature of the surface will have the binding mode associated with a surface from a different reference teaching a different surface having a distinctly different chemical nature. Even if one of skill in the art were motivated to combine the references, they would wind up with either a polylysine coated surface non-covalently bound to the probe moieties, OR a surface as described in Lefkowitz with functional groups for covalently binding to the probe moieties. The combination of cited art does not suggest a protein bioarray (or process of making a protein bioarray) having the probe proteins non-covalently bound to the substrate and

wherein the probe protein is not covalently bound to R². Applicants therefore respectfully request reconsideration of the rejection.

In light of the amendments to the claims and for the reasons discussed above, it is believed that the rejections of the claims under §112 and §103 are overcome. Swift allowance of the claims is respectfully requested. If any issues remain that may be resolved via a telephone call, the Examiner in charge of this case is invited to call the under-signed attorney.

Respectfully submitted,

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